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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/764,630	01/18/2001	James H. Goethel	L-F / 180DV	8472

26875 7590 05/02/2003

WOOD, HERRON & EVANS, LLP
2700 CAREW TOWER
441 VINE STREET
CINCINNATI, OH 45202

EXAMINER

HAYES, MICHAEL J

ART UNIT	PAPER NUMBER
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3763

DATE MAILED: 05/02/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Paper No. 9

Application Number: 09/764,630
Filing Date: January 18, 2001
Appellant(s): GOETHEL ET AL.

David Jefferies
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 2/07/03.

Art Unit: 3763

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The rejection of claims 1-11 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

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(9) Prior Art of Record

5,300,031

NEER et al.

4-1994

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-11 are rejected under 35 U.S.C. 102(b) as being anticipated by NEER et al. (U. S. Patent No. 5,300,031). Neer shows a syringe having a barrel, plunger with a knurled coupling element, conical front, syringe mating sections comprising an annular flange fixed to the syringe body, and an interior cavity in the coupling element (See Figs. 4,5,11,12). The coupling element is considered knurled because it includes a protuberance. The interior cavity in the coupling element is the side cavity formed by the protuberance and face of the plunger. Neer also discloses a movable face plate 127 movable by a rotatable lever 138.

(11) Response to Argument

Applicant's amendments to claim 2 to change its dependency and the changes to the drawings will be entered in the case.

Transverse Cross-Sections are the only Cross-Section in the Application.

Applicant's clarification of his intent in stating "... such a coupling element would exhibit discontinuity in cross-sections taken along its longitudinal axis," as meaning a transverse cross-section is noted by the examiner. (See Appeal Brief, Section B2 on pgs. 7 and 8). The examiner agrees that the claims only refer to cross-sections that are transverse, as these are the only cross-sections addressed in the application.

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Rejection Under 35 USC 102

Applicant argues that the rejection made under 35 USC 102 is improper because the reference does not disclose all the limitations recited in claim 1. Particularly, Applicant argues that the limitation of the coupling element extension "exhibiting no discontinuity in its transverse cross-sections along a portion of said extension adapted to be gripped by a coupling mechanism" is not shown in the prior art. Applicant states that Neer discloses a coupling element that exhibits discontinuity in transverse cross-sections. Applicant states that in adjacent transverse cross-sections taken at the connection between the extension and the cap (i.e., the smaller diameter portion 97 and larger diameter portion 98 of the coupling element of the prior art) Neer shows a discontinuity between such adjacent transverse cross-sections. Applicant argues that discontinuity in transverse cross-sections of a coupling element means that there are changes in the area of the transverse cross-sections when adjacent transverse cross-sections are compared. The examiner takes the position that Applicant is attempting to define claim terms contrary to their plain ordinary meaning to distinguish over the prior art.

Claim terms are interpreted using their plain ordinary meanings unless Applicant, acting as his or her own lexicographer, establishes his own definition of the terms in the written description. See Johnson Worldwide Associates, Inc., V. Zebco Corporation And Brunswick Corporation, 50 USPQ2d 1607, 1610 (Fed. Cir. 1999). The phrase "discontinuity in its transverse cross-sections" is plainly interpreted as a break or gap in the pictorial representation of a part when looking at any transverse plane made of the part. The claim limitation directs the skilled artisan to look at the transverse cross-sections of the coupling element and examine if any of the cross-sections exhibit a discontinuity in cross-section. No where in the specification has

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Applicant provided any definition of the phrase that would direct one of ordinary skill to interpret the phrase to mean to compare adjacent transverse cross-sections to see if there is a change in area. Applicant has not set forth any special definition of transverse cross-sections to limit its meaning to be as compared to adjacent cross-sections.

Neer clearly shows that there is no discontinuity in transverse cross-sections along the coupling element 98 as this phrase is commonly understood by the skilled artisan. (See Figs. 11, 12). Taking transverse cross-sections of the prior art coupling element extension one would consistently see a uniform circular profile in each cross-section taken. The prior art shows no discontinuity in any transverse cross-section made along the length of the coupling element even though some cross-sections will have different profile areas than other cross-sections.

Additionally, in his argument, Applicant argues a limitation that is not present in the claims. Applicant argues that Neer does not disclose the claimed invention because Neer discloses discontinuity along the gripped portion. However, Applicant does not limit the claim to the portion gripped by the coupling mechanism. The claim limitation is recited as a portion gripped. Clearly "a portion" consists of less than "the portion." Even if Applicant had recited a limitation regarding the entire gripped portion, the rejection would still stand. Neer clearly shows in Fig. 12 that the entire gripped portion is the cap (i.e., larger diameter portion) and there is no discontinuity in cross-sections contained in the cap.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,

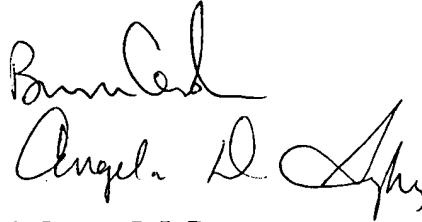


Michael J Hayes
Primary Examiner
Art Unit 3763

mjh

April 23, 2003

Conferees
Brian Casler
Angie Sykes



Wood, Herron & Evans, L.L.P.
2700 Carew Tower
Cincinnati, OH 45202